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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,393	10/08/2003	Marko H. Kokko	KOLS.055PA	7449

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/681,393

Applicant(s)

KOKKO, MARKO H.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8-16,18-23 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8-16, 18-23, and 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2007 has been entered.

2. Claims 1-3, 5, 6, 8-16, 18-23, and 30-36 have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15, 21, 31 and 36 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 15, it is unclear whether Applicant intends to claim a system for concealing the true identity of a user or a process for concealing the true identity of a user. The current claim language suggests that the Applicant is attempting to claim a product-by-process or product-by-system. However, it should be noted that only the process for concealing the true identity of a user will be given patentable weight and have art applied accordingly.

As per claim 21, it is unclear whether Applicant intends to claim a user equipment or a process. The current claim language suggests that the Applicant is attempting to claim a product-by-process or product-by-system. However, it should be noted that only the process for concealing the true identity of a user will be given patentable weight and have art applied accordingly.

As per claim 31, it is unclear whether Applicant intends to claim an apparatus or a process. The current claim language suggests that the Applicant is attempting to claim a product-by-process or product-by-system. However, it should be noted that only the process for concealing the true identity of a user will be given patentable weight and have art applied accordingly.

As per claim 36, it is unclear whether Applicant intends to claim an apparatus or a process. The current claim language suggests that the Applicant is attempting to claim a product-by-process or product-by-system. However, it should be noted that only the process for concealing the true identity of a user will be given patentable weight and have art applied accordingly.

In *IPXL Holdings, L.L.C. v Amazon.Com, Inc.* (CAFC, 05-1009, -1487, 11/21/2005), the court held a claim covering two statutory classes to be properly rejected under 112,2nd paragraph:

Whether a single claim covering both an apparatus and a method of use of that apparatus is invalid is an issue of first impression in this court. The Board of Patent Appeals and Interferences ("Board") of the PTO, however, has made it clear that reciting both an apparatus and a method of using that apparatus renders a claim indefinite under section 112, paragraph 2. *Ex parte Lyell*, 17 USPQ2d 1548 (BPAI 1990). As the Board noted in *Lyell*, "the statutory class of invention is important in determining patentability and infringement." *Id.* at 1550 (citing *In re Kuehl*, 475 F.2d 658, 665 (CCPA 1973); *Rubber Co. v. Goodyear*, 76 U.S. 788, 796 (1870)). The Board correctly surmised that, as a result of the combination of

two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus. *Id.* Thus, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. *Id.* at 1550-51. This rule is well recognized and has been incorporated into the PTO's Manual of Patent Examination Procedure. § 2173.05(p)(II) (1999) ("A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph."); see also Robert C. Faber, Landis on Mechanics of Patent Claim Drafting § 60A (2001) ("Never mix claim types to different classes of invention in a single claim.").

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 8, 10-12, 14-16, 18-22, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2001/0029496 to Otto ("Otto") in view of US Patent No. 7069249 to Stolfo et al. ("Stolfo").

Referring to claim 1, Otto discloses establishing a virtual identifier for a first user equipment in at least one of the following: the first user equipment and the service network (see paragraph [0045] – proxy server can establish information to provide an anonymous identity for the client computer & [0047] proxy server can disguise the user's IP address) and using the virtual identifier of the first user equipment for communication between the first and a second user equipment (paragraph [0045] -any information being transferred between client computer

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and any other web site on network is processed through proxy server). Otto does not expressly disclose linking the virtual identifier of the first user equipment to a first characteristic identifier of the first user equipment. Stolfo discloses linking the virtual identifier (i.e. proxy identifier/IP address) of the first user equipment to a first characteristic identifier (i.e. IP address) of the first user equipment (see fig. 9; col. 29, lines 46-48; col. 32, lines 46-67 and col. 33, lines 1-14 - In Stolfo's system the user computer's IP address is striped and substituted with a proxy computer IP address, so that the user's information may be private. Notice, the IP address and the proxy IP address are linked.) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method discloses by Otto to include the step of discloses linking the virtual identifier of the first user equipment to the first characteristic identifier of the first user equipment. One of ordinary skill in the art would have been motivated to do this because it "reduce the unwanted collection and/or dissemination of information related to users of a communications network" (see Stolfo, col. 5, lines 50-54).

Referring to claim 2, Otto discloses requesting the virtual identifier from a service network (i.e. proxy server) of the communications system, see claim 1 above.

Referring to claim 3, Otto discloses requesting multiple virtual identifiers from a service network of the communications system (see paragraph [0048] – proxy server allow the user to adopt one or more anonymous identities while accessing the network).

Referring to claim 5, Otto discloses providing a set of virtual identifiers in a service network in a communications system (see paragraph [0048] – proxy server allow the user to adopt one or more anonymous identities). Otto does not disclose one or more of the virtual identifiers being linked to the first characteristic identifier of the first user equipment. Stolfo

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discloses one or more of the virtual identifiers being linked to the first characteristic identifier of the first user equipment (see fig. 9; col. 32, lines 46-67 and col. 33, lines 1-14 - In Stolfo's system the user computer's IP address is striped and substituted with a proxy computer IP address, so that the user's information may be private. Notice, the IP address and the proxy IP address are linked.) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method discloses by Otto to include the step wherein one or more of the virtual identifiers being linked to the first characteristic identifier of the first user equipment. One of ordinary skill in the art would have been motivated to do this because it "reduce the unwanted collection and/or dissemination of information related to users of a communications network" (see Stolfo, col. 5, lines 50-54).

Referring to claim 6, Otto discloses selecting, in the service network, the virtual identifier to be used for communication between the first and the second user equipment (see claim 3 above).

Referring to claim 8, Otto discloses receiving at a service network of the communications system a request for establishing a communications connection between the first and the second user equipment, the request comprising the virtual identifier of the first user equipment (see paragraph [0045]).

Referring to claim 10, Otto discloses receiving the request for establishing the communications connection between the first and the second user equipment via an electronic mail server service (see paragraph [0047]).

Referring to claim 11, Otto discloses receiving the request for establishing the communications connection between the first and the second user equipment from the second

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user equipment (see paragraph [0047] – proxy server can serve as a re-emailing facility, by which the user can send and receive emails from a merchant or third party).

Referring to claim 12, Otto discloses receiving, in the first user equipment virtual identifier (see claim 1 above). Otto does not expressly disclose receiving information about the use of the virtual identifier of the first user equipment. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The receiving step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive any type of data because such data does not functionally elate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 14, Otto discloses virtual identifier (see claim 1 above). Otto does not expressly disclose predetermining one or more user equipment that have the right to use the virtual identifier. Stolfo discloses predetermining one or more user equipment that have the right to use the virtual identifier (see col. 29, lines 51-58). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Otto to include predetermining one or more user equipment that have the right to use the virtual identifier. One of ordinary skill in the art would have been motivated to do this because it “reduce the unwanted collection and/or dissemination of information related to users of a communications network” (see Stolfo, col. 5, lines 50-54).

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Claims 15, 16, 18-20 claim a system configured to perform the steps of method claims 1-3, 5 and 8 above; therefore, these claims are rejected on the same rationale as claims 1-3, 5 and 8 above.

Referring to claim 21, Otto discloses establish the virtual identifier for the first user equipment in at least one of the following: the first user equipment and the service network (see paragraph [0045] – proxy server can establish information to provide an anonymous identity for the client computer & [0047] proxy server can disguise the user's IP address) and use the virtual identifier of the first user equipment for communication between the first and a second user equipment (paragraph [0045] -any information being transferred between client computer and any other web site on network is processed through proxy server). Otto does not expressly disclose linking the virtual identifier of the first user equipment to the first characteristic identifier of the first user equipment. Stolfo discloses link the virtual identifier of the user equipment to a first characteristic identifier of the user equipment (see fig. 9; col. 32, lines 46-67 and col. 33, lines 1-14 - In Stolfo's system the user computer's IP address is striped and substituted with a proxy computer IP address, so that the user's information may be private. Notice, the IP address and the proxy IP address are linked.) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method discloses by Otto to include the step wherein one or more of the virtual identifiers being linked to the first characteristic identifier of the first user equipment. One of ordinary skill in the art would have been motivated to do this because it "reduce the unwanted collection and/or dissemination of information related to users of a communications network" (see Stolfo, col. 5, lines 50-54).

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Referring to claim 22, Otto discloses requesting the virtual identifier from the service network (i.e. proxy server), see claim 21 above.

Claim 23 is rejected on the same rationale as claim 12 above.

Referring to claim 30, Otto discloses establishing a connection between a first user equipment and a second user equipment (paragraph [0045] -any information being transferred between client computer and any other web site on network is processed through proxy server) when a virtual identifier is established for the first user equipment in at least one of the following: the first user equipment and the service network (see paragraph [0045] – proxy server can establish information to provide an anonymous identity for the client computer & [0047] proxy server can disguise the user's IP address) and the second user equipment using the first characteristic identifier for establishing a connection to the first user equipment (see paragraph [0047] – proxy server can serve as a re-emailing facility, by which the user can send and receive emails from a merchant or third party) . Otto does not expressly disclose linking the virtual identifier of the first user equipment to a first characteristic identifier of the first user equipment. Stolfo discloses linking the virtual identifier (i.e. proxy identifier/IP address) of the first user equipment to a first characteristic identifier (i.e. IP address) of the first user equipment (see fig. 9; col. 29, lines 46-48; col. 32, lines 46-67 and col. 33, lines 1-14 - In Stolfo's system the user computer's IP address is striped and substituted with a proxy computer IP address, so that the user's information may be private. Notice, the IP address and the proxy IP address are linked.) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method discloses by Otto to include the step of discloses linking the virtual identifier of the first user equipment to the first characteristic identifier of the first user

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equipment. One of ordinary skill in the art would have been motivated to do this because it “reduce the unwanted collection and/or dissemination of information related to users of a communications network” (see Stolfo, col. 5, lines 50-54).

Claims 31 and 34 claim an apparatus configured to perform the steps of claim 21 above; therefore, claims 31 and 34 are rejected on the same rationale as claim 21 above.

7. Claims 9, 23, 27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto and Stolfo as applied to claims 8, 21, 24 and 31 above, and further in view of WO 00/12364 to Lumme et al. (“Lumme”)

Referring to claim 9, Otto discloses receiving the request for establishing the communications connection between the first and the second user equipment (see claim 8 above). Otto does not expressly disclose using a short message service for transmitting the request. Lumme discloses using a short message service for transmitting the request (see abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method discloses by Otto to use short message service for receiving the request. One of ordinary skill in the art would have been motivated to do this because it quickly transmits information from a mobile phone to a recipient.

Claim 33 is rejected on the same rationale as claim 9 above.

8. Claims 13, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto and Stolfo as applied to claims 1, 31, 34 respectively above, and further in view of US Patent No. 6968385 to Gilbert.

Referring to claim 13, Otto discloses the virtual identifier (see claim 1 above). Otto does not expressly disclose predetermining a given validity period of the virtual identifier is valid. Gilbert discloses predetermining a given validity period of the identifier (i.e. IP address) is valid (see col. 6, lines 27-30 – the table includes the IP address and their expiration period). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method discloses by Otto to include the step of predetermining a given validity period during which the virtual identifier is valid. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized usage of the system.

Referring to claim 32, Otto discloses virtual identifiers (see claim 31 above). Otto does not expressly disclose a database of available virtual identifiers. Gilbert discloses a database of identifiers, i.e. IP address (see col. 2, lines 42-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the server discloses by Otto to include a database of available virtual identifiers. One of ordinary skill in the art would have been motivated to do this because a database organizes data for easy retrieval.

Referring to claim 35, Otto discloses virtual identifier (see claim 34 above). Otto does not expressly disclose the server is configured to compare a virtual identifier received from the user equipment or the second user equipment with characteristic identifiers linked to virtual identifiers in a database of the server for enabling establishing a connection between the first user equipment and the second user equipment. Gilbert discloses a server is configured to compare a virtual identifier received from the user equipment or the second user equipment with characteristic identifiers linked to virtual identifiers in a database of the server for enabling establishing a connection between the first user equipment and the second user equipment (see

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col. 2, lines 62-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the server discloses by Otto to compare a virtual identifier received from the user equipment or the second user equipment with characteristic identifiers linked to virtual identifiers in a database of the server for enabling establishing a connection between the first user equipment and the second user equipment. One of ordinary skill in the art would have been motivated to do this because it ensures that the user access has not expired (see col. 2, lines 62-67 of Gilbert).

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otto and Stolfo in view of Gilbert.

Otto discloses a first user equipment having a first characteristic identifier, a second user equipment having as second characteristic identifier, the service network connecting the first and the second user equipment one or more of the virtual identifiers established for the user equipment in at least one of the following the first user equipment and the service network (see claim 31 above). Otto does not expressly disclose one or more identifiers are linked to the respective characteristic identifiers of the user equipment are stored and linked to the respective characteristic identifiers of the user equipment, and where virtual identifiers received from the first user equipment or second user equipment are compared with the characteristic identifiers linked to the virtual identifiers for enabling the use of the virtual identifiers for communication between the first and the second user equipment. Stolfo discloses linking the virtual identifier (i.e. proxy identifier/IP address) of the first user equipment to a first characteristic identifier (i.e. IP address) of the first user equipment (see fig. 9; col. 29, lines 46-48; col. 32, lines 46-67 and

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col. 33, lines 1-14 - In Stolfo's system the user computer's IP address is striped and substituted with a proxy computer IP address, so that the user's information may be private. Notice, the IP address and the proxy IP address are linked.) . Gilbert discloses a database of identifiers, i.e. IP address (see col. 2, lines 42-45) and comparing a virtual identifier received from the user equipment or the second user equipment with characteristic identifiers linked to virtual identifiers in a database of the server for enabling establishing a connection between the first user equipment and the second user equipment (see col. 2, lines 62-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Otto to include one or more identifiers are linked to the respective characteristic identifiers of the user equipment are stored and linked to the respective characteristic identifiers of the user equipment, and where virtual identifiers received from the first user equipment or second user equipment are compared with the characteristic identifiers linked to the virtual identifiers for enabling the use of the virtual identifiers for communication between the first and the second user equipment. One of ordinary skill in the art would have been motivated to do this because a database organizes data for easy retrieval.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jalatee Worjloh
Primary Examiner
Art Unit 3621

March 20, 2007